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09/489,310	01/21/2000	Gary Stephenson	7922	5677

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EXAMINER

KRASS, FREDERICK F

ART UNIT PAPER NUMBER

1614

DATE MAILED: 11/16/2006

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/489,310
Filing Date: January 21, 2000
Appellant(s): STEPHENSON, GARY

S. Robert Chuey
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 31, 2006 appealing from the Office action mailed January 9, 2003.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(8) Evidence Relied Upon

3,681,091	Kohl et al.	8-1972
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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 23-31 are rejected under 35 USC 102(b) as being anticipated by Kohl et al (USP 3,681,091).

Patentees disclose fruit juices which comprise 0.1 to 5 weight percent linear sodium or potassium polyphosphates having 14 to 100 repeating units (preferably 16 to 37). See the passage bridging column 1, line 60 to column 2, line 9, and the passage bridging column 2, line 51 to column 2, line 6. Note also that the working examples comprehensively test polyphosphates having various specific chain lengths within that range (see especially Table VII and XI, following columns 13 and 14). The juices are acidic. See example 24 at column 13

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(orange juice having pH 4.10) and column 15, line 11 (apple cider having pH 3.6). They do not contain any substantial amounts of calcium or fluoride.

The juices of the prior art are thus beverages within the scope of the instant claims. This factual point has never been in dispute. It is the examiner's position, however, that the term "in need thereof" does not distinguish the instant methods for treating dental erosion over simply drinking the fruit juices of the prior art. The reasoning underlying this conclusion is discussed in detail in section "(10)" infra.

(10) Response to Argument

A. Interpretation of the Phrase "In Need thereof"

Appellant correctly notes that the examiner, in the Office Action dated November 1, 2004, stated that inserting the language "in need thereof" would place the claims in condition for allowance, based on the reasoning set forth by the CAFC in Jansen v. Rexall, 342 F.3d 1329 (Fed. Cir. 2003). The same suggestion was also made in the Office Action dated March 17, 2004. (Supplemental Appeal Brief, page 3, penultimate paragraph).

Appellant continues:

In direct response to the Examiner's suggestions the Appellant made the suggested amendment. In a gratuitous explanation for the Amendment, the Appellant mentioned that liquids are an essential part of everyone's diet. And therefore, everyone is in need of beverages.

The examiner now asserts that these statements made during prosecution obviate the amendments.

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Appellant's actual statement was:

As stated throughout the present specification, drinking low pH beverages contributes to dental erosion. Thus, anyone drinking a low pH beverage composition is in need of the compositions of the present invention. On a broader scale, all mammals need liquids to survive, so to a certain extent, we are always in need of beverages. (Appellant's remarks dated 04/08/2005, page 4, final paragraph; emphasis added).

Gratuitous or not, that statement is part of the prosecution history.

The Jansen court, conversely, was clear in stating:

Our conclusion as to the meaning of the claims is bolstered by an analysis of the prosecution history. The prosecution history is often useful to ascertain the meaning of the claim language. Indeed, claims are not construed in a vacuum, but rather in the context of the intrinsic evidence, viz., the other claims, the specification, and the prosecution history. (Jansen, page 1158; emphasis added).

Thus, the term "in need thereof" does not stand alone. In this case, the prosecution history (in the form of Appellant's "gratuitous" statement) indicates that anyone drinking acidic beverages (such as the fruit juices of the prior art) is "in need" of protection from dental erosion, and the specification provides no guidance to contradict or clarify that interpretation. To the contrary, the specification defines dental erosion in very general terms as the "softening of dental enamel" due to the action of acids (page 4, lines 10 and 11), a phenomenon broadly applicable to anyone having natural teeth.

Adopting the above rationale means that all individuals having natural teeth who drink the Kohl et al juices are necessarily (inherently) "in need" of treatment of dental erosion. The position is not unreasonable, and is not contradicted by the teachings of the specification as originally filed. Accordingly, it casts sufficient doubt, in this particular fact situation, on the sufficiency of the phrase "in need thereof" in distinguishing over inherently anticipatory prior art, so as to render the instant claims unpatentable.

B. Scope of the Jansen Holding

Appellant is correct in noting (Supplemental Appeal Brief, page 4, second paragraph) that the Jansen decision discusses only the phrase “in need thereof”, and not more restrictive language. The examiner notes, however, that the additional language he suggested (“who has been directed to ingest, for the purpose of treating said dental erosion”) comes from Appellant’s own specification at page 5, lines 7-25, and not from Jansen. The language was only suggested in an attempt to move prosecution forward; it is not the examiner’s position that the Jansen decision “requires” (or even discusses) that particular language.

The examiner does not agree, however, that the Jansen case “deals with enforceability rather than patentability of the claims.” (Supplemental Appeal Brief, page 4, third paragraph; emphasis added). As is clear from the preceding discussion, it deals with both. The fact that distinctions may be made at the marketing/infringement stage (Supplemental Appeal Brief, page 4, last paragraph) is not relevant to determining the allowability of the claims during prosecution.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

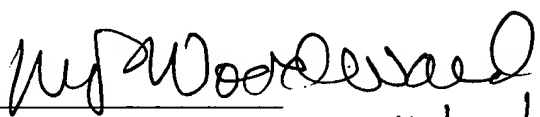


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11/13/06